

AMENDMENT UNDER 37 C.F.R. § 1.116
U.S. Application No. 09/980,712
Attorney Docket No. Q67023

REMARKS

Claims 1-17 are all the claims pending in the application.

I. Information Disclosure Statement

Applicants thank the Examiner for clarifying that the international search report of the present 37 C.F.R. § 371 National Stage Application has been considered and placed in the application file.

II. Claim Amendments

As a point of clarification, the Examiner notes that claim 17 lacks proper antecedent basis for the phrases “said bottom plate” and “said cover plate” (see Office Action, page 2, lines 1-2). Applicants amend claim 17 to provide proper antecedent basis.

Additionally, claims 1 and 5 are amended to more clearly define the features of the claimed invention.

Further, Applicants respectively amend claims 2, 11, 14, 15, and 16 to make minor editorial changes and to provide proper antecedent basis. These amendments are not believed to change the scope of the claims.

III. Anticipation Rejections

A. Claims 1 and 3:

The Examiner maintains and makes final the rejection claims 1 and 3 under 35 U.S.C. § 102(b) as being anticipated by JP 09-169383 (hereinafter, JP '383). In the Examiner's Response to Arguments, the Examiner takes the position that the phrase "the neighboring portions of the connecting portions of the plate and the walls" reads on the ribs/stops 52 of JP '383. For at least the following reasons, Applicants respectfully disagree with the Examiner's position, and therefore, traverse this rejection.

As a preliminary matter, Applicant submits that claim 1 has been amended to define more clearly the features of the invention. For example, independent claim 1 (as amended) recites, *inter alia*:

"wherein on at least one of a connecting portion between said bottom plate and said inner walls of said storage part and a connecting portion between said cover plate and said outer walls of said cover part, there are provided at least one pair of ribs so as to project inwardly of said storage part or said cover part".

It is settled law that, to anticipate a claim, the prior art reference must disclose all of the features recited in the claim in as complete detail as recited in the claim. In construing the claims, the Examiner must consider all of the recitations of the claims and interpret them as broadly as reasonably possible consistent with the specification.

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Contrary to the Examiner's position, Applicants respectfully submit that JP '383 neither discloses nor suggests that the ribs 52 are provided "on at least one of *a connecting portion* between said bottom plate and said inner walls of said storage part and *a connecting portion* between said cover plate and said outer walls of said cover part", as recited in claim 1 (emphasis added). Instead, JP '383 discloses two pairs of stops 52 for holding a restricted piece 51 which are disposed in the central portion 43a of the case 43, not on the connecting portions of the plate and the walls. Therefore, for at least the foregoing reasons, Applicants submit that JP '383 clearly does not anticipate independent claim 1. Accordingly, Applicants respectfully request the Examiner to withdraw the § 102(b) rejection of claim 1 (and dependent claim 3) and to permit these claims to pass to allowance.

B. Claims 9-11 and 16:

The Examiner rejects claims 9-11 and 16 under 35 U.S.C. § 102(b) as being anticipated by Weisburn (U.S. Patent No. 5,597,068). The Examiner maintains that Weisburn discloses one or more ribs (40-43, 46, and 47) that inherently are capable of storing a magnetic tape cassette and holding an information sheet therein. Additionally, in the Response to Arguments, the Examiner takes the position that Weisburn discloses a container for storing various articles, such as a jewel box 70 and similar data storage articles, which are considered by the Examiner to be equivalent to the magnetic tape cassette, as recited in claim 9. Further, the Examiner alleges that Weisburn discloses a clearance between the similar data storage articles 70 and the holder 55

when the container is in a closed position, as shown in Figure 7. For at least the following reasons, Applicants traverse this rejection.

It is settled law that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

Applicants submit that Weisburn fails to disclose all of the recitations of independent claim 9 in as complete detail as recited in claim 9.

For example, independent claim 9 recites, *inter alia*:

“the dimension of said hinge part is set such that, *when said cover part is closed while said magnetic tape cassette is stored*, between said cover part and said magnetic tape cassette, *there can be defined a clearance capable of storing a sheet bundle therein*; and, *in the range of said clearance* and on said hinge part, *there are disposed one or more ribs* each including mutually opposed surfaces” (emphasis added).

As set forth above, the Examiner takes the position that the jewel box 70 and similar data storage articles are considered to be *equivalent* to the magnetic tape cassette, as recited in claim 9. As such, the Examiner alleges that Weisburn discloses a clearance between the similar data storage articles 70 (compared by the Examiner as being equivalent to the claimed magnetic tape cassette) and the holder 55 when the container is in a closed position, as shown in Figure 7.

However, Applicants submits that the “jewel box 70 and similar data storage articles” are not construed properly as being *equivalent* to a magnetic tape cassette, as alleged by the Examiner.

On the contrary, Applicants respectfully submit that the Examiner is mischaracterizing the Weisburn reference. For example, Weisburn specifically states that “[w]hen holder 55 and jewel

box 70 are removed from panel 12, container 1 may be used to store other articles such as video tapes, audio tapes or video game cartridges” (see col. 6, lines 2-5). In other words, Weisburn discloses that the holder 55 interferes with the storage of a cassette cartridge in the container 1 and cannot be contained in a clearance between the cassette and the container lid 10. Therefore, since the receptacles 40-43, 46, and 47 (compared by the Examiner to the claimed ribs) are disposed on the hinge of the Weisburn container 1 to hold the holder 55, the receptacles would be disposed in a location that is aligned with the holder 55. As such, the receptacles also would not be disposed within a clearance between a cassette stored in the container 1 and the lid 10 of the container.

For at least the foregoing reasons, Applicants submit that Weisburn clearly does not disclose, either expressly or inherently, that the dimension of the hinge part is set such that, when the cover part is closed while the magnetic tape cassette is stored, there is a clearance defined between the cover part and the magnetic tape cassette that is capable of storing a sheet bundle therein and that *one or more ribs are disposed on the hinge part and in the range of such a clearance*, as recited in claim 9. Thus, Applicants submit that at least some modification of Weisburn would be necessary to arrive at the claimed combination. Such being the case, Weisburn clearly does not anticipate all of the features of claim 9. As an aside, Applicant notes that the rejection of claim 9 as being obvious over Weisburn is addressed in the remarks set forth below.

For at least the foregoing reasons, Applicants submit that the claimed invention is not inherently disclosed by Weisburn, as alleged by the Examiner. Accordingly, Applicants request

that the Examiner withdraw the § 102(b) rejection of independent claim 9 (and dependent claims 10, 11, and 16).

IV. Obviousness Rejections

A. Claims 1, 3, and 4:

The Examiner rejects claims 1, 3, and 4 under 35 U.S.C. § 103(a) as being obvious over JP '383 and JP 149872 (hereinafter, "JP '872"). Applicants respectfully submit that neither JP '383 nor JP '872, either alone or in combination, discloses or suggests the claimed combination, as recited in independent claim 1. Therefore, Applicants traverse this rejection.

As a preliminary matter, Applicants note that, in the Response to Arguments, the Examiner points out that Figures 1-5 of JP '383 are relied upon in rejecting claims 1, 3, and 4, not Figure 6. However, Applicants respectfully submit that Figures 1-5 of JP '383, which disclose the alleged rib 13, also do not disclose or suggest all of the recitations of claims 1, 3, and 4, as alleged by the Examiner.

For example, independent claim 1 (as amended) recites, *inter alia*:

“wherein on at least one of a connecting portion between said bottom plate and said inner walls of said storage part and a connecting portion between said cover plate and said outer walls of said cover part, there are provided at least one pair of ribs so as to project inwardly of said storage part or said cover part,

wherein said ribs define, between the back surface or front surface of said magnetic tape cassette and said bottom plate of said storage part or said cover plate of said cover part, a predetermined clearance capable of storing an information sheet therein”.

Applicants submit that JP '383 neither discloses nor suggests that the ribs 13 are provided "on at least one of *a connecting portion* between said bottom plate and said inner walls of said storage part and *a connecting portion* between said cover plate and said outer walls of said cover part", as recited in claim 1 (emphasis added). Instead, JP '383 discloses a stopper 13 (compared by the Examiner to the claimed rib) that is *molded as an integral part of the flat plate 3a*, which is a component of the lid 3. That is, the stopper 13 is not provided on the connecting portions of the plate and the walls, as claimed.

Additionally, Applicants submits that JP '872 fails to make up for the deficiencies of JP '383. Instead, Applicants submit that the alleged ribs of JP '872 are not "ribs", as claimed by Applicants. For example, JP '872 discloses a pair of ribs 12 that are disposed on the surface of the outer walls of the cover part 11 on the neighboring portions of the connecting portions between the bottom plate and the walls (see Fig. 4). In Figure 4 of JP '872, the ribs 12 are depicted as supporting the information sheet 17. However, as shown in Figure 3, the ribs 12 engage the outer surface of the inner walls of the storage part 14 when the storage case is in the closed position. That is, the ribs 12 engage the projections 15 to lock the case in the closed position. As such, the ribs 12 do not define a clearance between the tape cassette and the storage part or cover part, as recited in claim 1. On the contrary, as shown in Figure 3, the inner walls 14a of the storage part 14 are interposed between the ribs 12, which are formed on the outer walls of the cover part, and the tape cassette 18. As such, the tape cassette 18 is free to contact directly the information sheet 17. Thus, the ribs 12 are not "ribs" as recited in claim 1. That is,

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the ribs 12 do not, and cannot, define a clearance between the tape cassette and the storage part or the cover part, as recited in claim 1.

Therefore, for at least the foregoing reasons, Applicants submit that JP '872 clearly does not make up for the deficiencies of JP '383. Instead, Applicants submit that the combination of JP '383 and JP '872 merely would result in the device of JP '383 with locking ribs 12 for engaging projections 15 to keep the container in a closed position. Thus, Applicants submit that any device resulting from the combination of JP '383 and JP '872 would not disclose or suggest all of the recitations of independent claim 1. As such, Applicants submit that claims 1, 3, and 4 would not have been obvious over any combination of JP '383 and JP '872.

With respect to the Examiner's Response to Arguments, in which the Examiner states that "there does not appear to be anything unobvious about providing two ribs in lieu of one rib for better holding the information sheet", Applicants respectfully disagree. It is settled law that the factual inquiry whether to combine references must be thorough and searching and must be based on objective evidence of record. As such, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. Thus, Applicants respectfully submit that, a mere conclusory statement that "there does not appear to be anything unobvious about providing two ribs in lieu of one rib for better holding the information sheet" does not adequately address the issue of motivation to combine. Recent Federal Circuit case law makes clear that this factual question of motivation is material to patentability and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would

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have been led to this combination of references, simply to use that which the inventor taught against its teacher.

Thus, for at least the forgoing reasons, Applicants respectfully submit that claims 1, 3, and 4 would not have been obvious over any combination of JP '383 and JP '872, and therefore, respectfully request the Examiner to withdraw this rejection.

B. Claims 2 and 5-8:

The Examiner rejects claims 2 and 5-8 under 35 U.S.C. § 103(a) as being obvious over JP '383, JP '872, Mallery (U.S. Patent No. 5,697,497), and Hehn et al. (U.S. Patent No. 4,643,301). For at least the following reasons, Applicants traverse these rejections.

Claim 2

As a preliminary matter, Applicants notes that, in the Response to Arguments, the Examiner points out that Figures 1-5 of JP '383 are relied upon in rejecting claim 2, not Figure 6. However, Applicants respectfully submit that Figures 1-5 of JP '383, which disclose the alleged rib 13, also do not disclose or suggest all of the recitations of independent claim 1, from which claim 2 depends.

For example, as set forth above, JP '383 discloses a stopper 13 (compared by the Examiner to the claimed rib) that is *molded as an integral part of the flat plate 3a*, which is a component of the lid 3. That is, the stopper 13 is not provided on the connecting portions of the plate and the walls, as claimed.

Additionally, JP '872 discloses a pair of ribs 12 that are disposed on the surface of the outer walls of the cover part 11 on the neighboring portions of the connecting portions between the bottom plate and the walls (see Fig. 4). However, as shown in Figure 3, the ribs 12 engage the outer surface of the inner walls of the storage part 14 when the storage case is in the closed position. As such, the ribs 12 do not define a clearance between the tape cassette and the storage part or cover part, as recited in independent claim 1. Thus, the ribs 12 do not, and cannot, define a clearance between the tape cassette and the storage part or the cover part, as recited in independent claim 1.

On the other hand, Mallery discloses slot flanges 116 and 118 that extend along most of the length of the side edges 112 and 114 to form continuous slots for receiving a booklet (see Fig. 2). That is, the booklet is inserted in the slots formed by the edges 120 and 122 of the flanges 116 and 118 (see col. 4, lines 10-23). However, Mallery does not disclose or suggest that the slot flanges 116 and 118 define a clearance between the compact disc and the information sheets. In fact, Mallery does not disclose or suggest that the slot flanges support the compact disc. Instead, as shown by Mallery, the compact disc is supported by a central art on the storage portion 104. Thus, the slot flanges 116 and 188 of Mallery also do not, and cannot, define a clearance between the compact disc, or a tape cassette, and the storage part or the cover part, as recited in independent claim 1. As such, Mallery also does not make up for the deficiencies of JP '383 and JP '872, either alone or in combination.

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Thus, Applicants submit that any combination of JP '383, JP '872, and Mallery neither discloses nor suggests all of the recitations of independent claim 1, from which claim 2 depends. Accordingly, Applicants respectfully request the Examiner to withdraw this rejection.

As an aside, Applicants note that Hehn was not cited in the explanation of the rejection of claim 2. However, Applicants submit that, even if Hehn were combined with JP '383, JP '872, and Mallery, the resulting combination would not arrive at the claimed invention in as complete detail as recited in the claim. Moreover, since the Examiner has not mentioned Hehn in the rejection of claim 2, Applicants submit that, if Hehn was intended to be applied, a *prima facie* case of obviousness of claim 2 has not been established with respect to the combination of the aforementioned references and Hehn.

With respect to the Examiner's Response to Arguments, in which the Examiner states that there does not appear to be anything unobvious about providing two short ribs as modified, or the ribs disposed substantially over the entire area of the connecting portions, for better securing the information sheet within the case, Applicants respectfully disagree with the Examiner's position. As set forth above, it is settled law that the factual inquiry whether to combine references must be thorough and searching and must be based on objective evidence of record. Thus, Applicants respectfully submit that, the aforementioned conclusory statement that does not adequately address the issue of motivation to combine.

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Accordingly, Applicants submit that claim 2 would not have been obvious from any combination of JP '383, JP '872, and Mallery, and therefore, respectfully request the Examiner to withdraw this rejection.

Claims 5-8

With respect to claims 5-8, the Examiner rejects claims 5-8 under 35 U 103(a) as being obvious over JP '383, JP '872, Mallery, and Hehn.

To make up for the deficiencies of JP '383, JP '872, and Mallery, the Examiner looks to Hehn for the disclosure of a back cover of a booklet that engages a video cassette storage case. In the present Office Action, the Examiner expands upon the previous explanation of this rejection (as set forth in the Office Action dated January 21, 2003) and alleges that Hehn shows a cover part 3 having recesses 44 and a sheet-shaped member 2 disposed substantially parallel to a cover plate of the cover part having two end portions with ribs 34 to engage/fix with the recess to provide a predetermined clearance between the cover plate and the sheet-shaped member capable of storing an information sheet 46 therein. Additionally, the Examiner alleges that it would have been obvious to modify the case of JP '383 to include a sheet-shaped member disposed substantially parallel to a cover plate of the cover part having two end portions fixed to the ribs for better protecting the information sheet therein. For at least the following reasons, Applicants respectfully disagree with the Examiner's position, and therefore, traverse this rejection.

Hehn discloses a booklet pocket for a video cassette storage container. In particular, Hehn discloses a pocket forming panel 2 that can be removeably mounted on the outside of the

end wall 5 of the storage container 3, or alternatively, to the outside of the lid 12, to form a pocket therebetween (see, e.g., Figs. 1-3, 5, 7, and 8 of Hehn). That is, Hehn merely discloses a pocket forming panel 2 that can be attached to the outside of a cassette storage case by the notches 44 (see col. 6, lines 2-7).

In comparison, claim 5 recites, *inter alia*:

“wherein a pair of ribs are provided *on connecting portions* of said cover plate and said side walls of said cover part *so as to project inwardly* of said cover part; and,

a sheet-shaped member disposed substantially parallel to said cover plate of said cover part with a given distance between them, said sheet-shaped member having two end portions that are *fixed to said ribs*, said sheet-shaped member defining, between said cover plate of said cover part and itself, a predetermined clearance capable of storing an information sheet therein” (emphasis added).

For the reasons that are analogous to the reasons set forth above with respect to claim 1, Applicants submit that neither JP ‘383, JP ‘872, nor Mallery, either alone or in combination, discloses or suggests at least a pair of ribs being provided on connecting portions of the cover plate and the side walls of the cover part, as recited in claim 5. Additionally, since the pocket forming panel 2 of Hehn is mounted on the outside of the cassette storage case, Hehn does not, and cannot, disclose or suggest at least the claimed “pair of ribs that project inwardly of the cover part”, as recited in independent claim 5. Accordingly, Hehn also does not, and cannot, disclose or suggest a sheet-shaped member having two end portions that are fixed to ribs that

project inwardly of the cover part, as recited in claim 5. Thus, Applicants submit that Hehn clearly does not make up for the deficiencies of the aforementioned references.

Furthermore, in the Response to Arguments, the Examiner asserts that there is nothing in the claims that indicates that the ribs are disposed within the case when the case is in a closed position. Applicants respectfully disagree with the Examiner's position. For example, claim 5 recites, *inter alia*, "wherein a pair of ribs are provided on connecting portions of said cover plate and said side walls of said cover part *so as to project inwardly of said cover part*".

For at least the foregoing reasons, Applicants submit that Hehn does not make up for the deficiencies of JP '383, JP '872, or Mallery. Therefore, Applicants submit that independent 5 (and dependent claims 6-8) would not have been obvious over any combination of the applied references.

Additionally, Applicants submit that dependent claims 6-8 independently and separately are patentable over the applied references, at least by virtue of the additional recitations recited therein. For example, claim 6 recites, *inter alia*, that the "ribs are respectively structured in such a shape that, when said magnetic tape cassette is stored, said ribs are operable to press against said magnetic tape cassette to said storage part side." However, the externally mounted pocket forming panel 2 of Hehn does not even contact the tape cassette, which is enclosed inside the video cassette storage case 3. Therefore, Hehn also clearly does not disclose or suggest at least ribs that are structured in such a shape that, when the tape cassette is stored, the ribs are operable to press against the tape cassette, as recited in claim 6.

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Thus, Applicants submit that claims 5-8 would not have been obvious over any combination of the applied references. Accordingly, Applicants respectfully request the Examiner to withdraw the § 103 rejection of claims 5-8.

C. Claims 9-17:

The Examiner maintains and makes final the rejection of claims 9-17 under 35 U.S.C. § 103(a) as being obvious over Weisburn. As with the rejection of claim 9 under 35 U.S.C. § 102, in the Response to Arguments, the Examiner takes the position that the various articles, such as the jewel box 70, are equivalent to the magnetic tape cassette, as claimed. Additionally, the Examiner alleges that it would have been a matter of obvious design choice to modify the receptacles of Weisburn to arrive at the claimed invention. Applicants respectfully disagree with the Examiner's position for at least the following reasons.

As set forth above, Applicant respectfully submits that the Examiner is mischaracterizing Weisburn. As such, Weisburn fails to disclose all of the features of claim 9, and accordingly, it would have been necessary to modify Weisburn to arrive at the claimed invention. However, Applicants submit that it is not enough to establish merely that the reference can be modified to arrive at the claimed invention. Instead, to establish a *prima facie* case of obviousness, the Examiner also must show that Weisburn, or the prior art in general, suggests modifying Weisburn to arrive at the claimed invention in as complete detail as recited in the claims.

In this respect, the Examiner alleges that it would have been obvious to modify Weisburn to arrive at the claimed invention because it allegedly would have been a matter of obvious

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design choice, since the resultant structure allegedly would work equally well. Applicants respectfully disagree. However, Applicants submit that it is not necessary to address the obviousness of the individual arrangement of the ribs set forth in dependent claims 10-17 at this time, since a *prima facie* case of obviousness has not yet been established with respect to independent claim 9, from which claims 10-17 depend.

With respect to the obviousness of independent claim 9, Applicant submits that the Examiner has not established that claim 9 would have been obvious from the disclosure of Weisburn, since Weisburn does not disclose or suggest all of the recitations of claim 9. In particular, Weisburn neither discloses nor suggests that:

“the dimension of said hinge part is set such that, *when said cover part is closed while said magnetic tape cassette is stored, between said cover part and said magnetic tape cassette, there can be defined a clearance capable of storing a sheet bundle therein; and, in the range of said clearance and on said hinge part, there are disposed one or more ribs each including mutually opposed surfaces*”, as recited in claim 9 (emphasis added).

On the contrary, Weisburn specifically discloses that the container 1 is not capable of storing a cassette while the holder 55 is mounted in the receptacles 40-43 (see col. 6, lines 2-5). Thus, the container 1 of Weisburn also would not be capable of storing a cassette while also storing a sheet bundle in the receptacles (compared by the Examiner to the claimed ribs), as recited in claim 9.

Accordingly, some motivation or suggestion would be necessary to modify Weisburn to arrive at the claimed invention. That is, the prior art must provide a motivation or reason for a

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worker in the art, without the benefit of Applicants' specification, to make the necessary changes to the reference device (see MPEP § 2144.04). However, Applicants submit that Weisburn fails to establish such a motivation or suggestion for modifying the container 1 to arrive at the claimed invention. In fact, Weisburn does not contemplate or mention storing a sheet bundle in the receptacles 40-43, but instead, discloses only that a holder 55 is snap-fit mounted into the receptacles 40-43.

For at least the foregoing reasons, Applicants submit that independent claim 9 (and dependent claims 10-17) would not have been obvious from Weisburn, and therefore, respectfully request that the Examiner withdraw this rejection.

V. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

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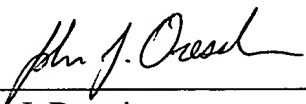
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Date: August 28, 2003